

REMARKS/ARGUMENTS

Claims 23-30 are pending in this application. Claim 30 has been withdrawn from further consideration as being directed to a non-elected species. By this Amendment, Applicant amends Claim 23.

Claim 30 is dependent upon generic Claim 23. Accordingly, Applicant respectfully requests that the Examiner rejoin and allow Claim 30 when generic Claim 23 is allowed.

Claims 23-27 were rejected under 35 U.S.C. § 102(b) as being anticipated by Wermer et al. (WO 02/19430). Claims 23-27 were rejected under 35 U.S.C. § 102(a) as being anticipated by Hirabayashi et al. (US 2004/0066617). Claims 28 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wermer et al. in view of Takehara et al. (U.S. 2003/0071350). Claims 28 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hirabayashi et al. in view of Takehara et al. (U.S. 2003/0071350). Applicant respectfully traverses the prior art rejections of Claims 23-29.

Claim 23 has been amended to recite:

A ceramic multilayer substrate comprising:
a ceramic laminate including a plurality of ceramic layers, having a first main surface, and including internal circuit elements disposed inside of the laminate;
a resin layer having a bonding surface in contact with the first main surface of the ceramic laminate and a mounting surface opposite to the bonding surface and arranged to face and be mounted to a mother board;
external electrodes, each disposed on the mounting surface of the resin layer and electrically connected to at least one of the internal circuit elements of the ceramic laminate; and
a ground electrode disposed inside of the resin layer; wherein
the ground electrode is arranged to overlap at least one of the external electrodes in a direction of lamination of the plurality of ceramic layers. (emphasis added)

The Examiner alleged that each of Wermer et al. and Hirabayashi et al. teaches all of the features recited in Applicant's Claim 23.

Applicant's Claim 23 has been amended to recite the feature of "a resin layer having a bonding surface in contact with the first main surface of the ceramic laminate and a mounting surface opposite to the bonding surface and arranged to face and be mounted to a mother board." Support for this feature is found, for example, in the first full paragraph on page 15 of the Substitute Specification and in Figs. 1-7 of the originally filed drawings.

In contrast to Applicant's Claim 23, the organic portion 80 of the substrate 50 of Wermer et al., which the Examiner alleged corresponds to the resin layer recited in Applicant's Claim 23, is disposed between the ceramic laminate 90 and the processor die 60, and is disposed on the opposite main surface of the ceramic laminate 90 from the mother board 200. In other words, the organic portion 80 of Wermer et al. has a bonding surface in contact with the opposite main surface of the ceramic laminate 90 from the mother board 200 and a mounting surface opposite to the bonding surface and arranged to face the processor die 60, **NOT** arranged to face the mother board 200. Wermer et al. fails to teach or suggest any resin layer whatsoever that has a mounting surface that is arranged to face the mother board 200, or that a resin layer could or should be provided in the device of Wermer et al. so as to have a mounting surface that faces the mother board 200.

Thus, Wermer et al. certainly fails to teach or suggest the feature of "a resin layer having a bonding surface in contact with the first main surface of the ceramic laminate and a mounting surface opposite to the bonding surface and arranged to face and be mounted to a mother board" as recited in Applicant's Claim 23.

Similarly, Hirabayashi et al. (Fig. 19) teaches an insulating layer 6, which the Examiner alleged corresponds to the resin layer recited in Applicant's Claim 23, is disposed between the ceramic laminate 4 and the semiconductor component 42, and is disposed on the opposite main surface of the ceramic laminate 4 from the mother board 20. In other words, the insulating layer 6 of Hirabayashi et al. has a bonding surface in contact with the opposite main surface of the ceramic laminate 4 from the

mother board 20 and a mounting surface opposite to the bonding surface and arranged to face the semiconductor component 42, **NOT** arranged to face the mother board 20. Hirabayashi et al. fails to teach or suggest any resin layer whatsoever that has a mounting surface that is arranged to face the mother board 20, or that a resin layer could or should be provided in the device of Hirabayashi et al. so as have a mounting surface that faces the mother board 20.

Thus, Hirabayashi et al. certainly fails to teach or suggest the feature of "a resin layer having a bonding surface in contact with the first main surface of the ceramic laminate and a mounting surface opposite to the bonding surface and arranged to face and be mounted to a mother board" as recited in Applicant's Claim 23.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 23 under 35 U.S.C. § 102(b) as being anticipated by Wermer et al., and the rejection of Claim 23 under 35 U.S.C. § 102(a) as being anticipated by Hirabayashi et al.

The Examiner relied upon Takehara et al. to alleged cure deficiencies of Wermer et al. and Hirabayashi et al. However, Takehara et al. clearly fails to teach or suggest the feature of "a resin layer having a bonding surface in contact with the first main surface of the ceramic laminate and a mounting surface opposite to the bonding surface and arranged to face and be mounted to a mother board" as recited in Applicant's Claim 23. Thus, Applicant respectfully submits that Takehara et al. fails to cure the deficiencies of Wermer et al. and Hirabayashi et al. described above.

Accordingly, Applicant respectfully submits that Wermer et al., Hirabayashi et al., and Takehara et al., applied alone or in combination, fail to teach or suggest the unique combination and arrangement of features recited in Applicant's Claim 23.

In view of the foregoing amendments and remarks, Applicant respectfully submits that Claim 23 is allowable. Claims 24-29 depend upon Claim 23, and are therefore allowable for at least the reasons that Claim 23 is allowable. In addition, Applicant respectfully requests that the Examiner rejoin and allow non-elected Claim 30.

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In view of the foregoing amendments and remarks, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

To the extent necessary, Applicant petitions the Commissioner for a One-Month Extension of Time, extending to February 9, 2009 (February 8, 2009 falls on a Sunday), the period for response to the Office Action dated October 8, 2008.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

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